

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of trademark application Serial No. 76/572,253
TTAB Opposition 91165809
For Plastic water bottle, sold empty, in IC 21
Published in the Official Gazette on (Date) 3/18/2005

TRIFOREST ENTERPRISES INCORPORATED
v.
NALGE NUNC INTERNATIONAL CORPORATION

**OPPOSER'S RESPONSE TO NNI OBJECTIONS TO AND MOTION TO STRIKE
PORTIONS OF OPPOSER REPLY BRIEF;
OPPOSITION TO MOTION FOR SANCTIONS**

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Assistant Commissioner for Trademarks
P.O. Box 1451
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Opposer:
TriForest Enterprises, Inc.
17 Musick
Irvine, CA 92618

Applicant:
Nalge Nunc International Corporation a Delaware Corp.
75 Panorama Creek Drive
Rochester, NY 14602-0365

Applicant Nalge Nunc International Corporation ("NNI") argues that the opposer made arguments unsupported by evidence; introduced exhibits not properly entered during trial testimony; and introduced testimony that has been designated confidential. These allegations are both irrelevant and not substantially related to the key issue in this case which is the functionality and commonplace nature of the alleged Trademark claim. Opposer will address each of these allegations in the order raised.

TriForest understands that the formal name of the applicant is Nalge Nunc International

Corporation, but because the wordmark 'Nalgene' is better known, TriForest referred to the applicant as Nalgene for sake of clarity. Applicant Nalge Nunc International Corporation will hereinafter be referred to as 'NNI' or simply as the applicant.

A. TRIFOREST'S ARGUMENTS ARE REASONABLE INFERENCES FOR PURPOSES OF CLOSING ARGUMENT, RATHER THAN FOR PURPOSES OF INTRODUCING NEW EVIDENCE

Opposer strongly disagrees with the allegations that reply brief statements lacked foundation or were not established by evidence. NNI cites the T.B.M.P. 707.03 which establishes that "Statements made in pleadings cannot be considered as evidence on behalf of the party making them; such statements must be established by competent evidence during the time for taking testimony." The section in dispute is as follows:

"Customers who are in the lab market are well aware that this is a Boston round bottle with several utility functions. Lab media suppliers use these bottles for the ease of labeling with an applicator, rolling cultures, and the simplicity of its design for packaging that has been established as "traditional lab bottles". Customers in the lab were first to purchase these bottles for hiking and outdoor activities when they realized it was Nalgene brand also. The customers now buy Nalgene brand bottles, because Nalgene is an established name brand in laboratory market as well as the consumer water bottle market. As a result many consumers know and purchase Nalgene hydration products that include other designs as well as the stated Boston Round." (Opposer's Reply Brief)

The statements are supported by pages 6-8 of the transcript of the Lin deposition testimony.

6 bottle --

7 A Yes.

8 Q -- that's in Exhibit 1?

9 I'll show Exhibit 1, which is also Exhibit 1 of
10 the Motion for Summary Judgement.

11 (Opposer's Exhibit 1 was marked for
12 identification by the court reporter
13 and is attached hereto.)

14 THE WITNESS: Yes.

15 Q BY MR. CHENG: And does that photograph
16 accurately depict the bottles?

17 A Yes.

18 MR. SCHATZ: Excuse me. Do you have copies for ,
19 everybody?

20 MR. CHENG: Oh, yeah, let me run this off right
21 now.

22 MR. SCHATZ: Well, do you have a lot of
23 exhibits to go through?

24 MR. CHENG: No, I only have 13, nothing at all.

25 MR. SCHATZ: Don't worry about the copies for

1 now. I just may want to look at the exhibit while we're

2 discussing it.

3 MR. CHENG: Okay. Or maybe we should run one
4 off and you can have it to look at it.

5 MR. SCHATZ: I would appreciate at that.

6 (A brief recess was taken.)

7 Q BY MR. CHENG: All right. So have you seen the
8 Nalgene bottle before?

9 A Yes, I have, yes.

10 Q And so tell me about the Nalgene bottle.

11 A Actually, Nalgene is the company in the
12 laboratory business for many decades, and it's a well
13 known name. They make the laboratory bottle primarily
14 for the -- polycarbonate bottle for laboratory for
15 autoclavable bottle.

16 And in -- in the past, people, the scientists
17 in the laboratory -- or some of the scientists in the
18 laboratory, also the outdoor hiker, and they use the same
19 bottle for drinking the water. And some people may
20 suggest Nalgene to add a tether cap to the Nalgene Boston
21 round bottle, and that's come -- become the one they want
22 to trademark today. But my opinion is that the Boston
23 round bottle has exist in the market for almost a
24 dec- -- a century, and it should not be trademarked to

25 anyone by adding tether cap.

8

1 Q Was the Nalgene bottle originally without the
2 tether cap?

3 A Yes, in the laboratory, they sell the same
4 bottle without the tether cap. And by adding the tether
5 cap, they sell in the outdoor market, and this is the one
6 they want to trademark today. And it's actually the
7 simple Boston round bottle with tether.

8 Q But this tether has a button.

9 Isn't that button kind of special?

10 A No, actually, the -- the original cap is
11 without a tether, and they have to add a button to
12 con- -- interconnect to the tether. And this is the
13 cheapest way to make the tether attach to the cap without
14 making a new mold.

15 Q How do you get the button onto the cap without
16 making a new mold?

17 A Just simply ultrasonic welding.

18 Q Oh, okay. Then are there other ways of doing
19 that?

20 A There are -- there are other ways but they have

21 to make a new mold for.

22 Q Oh, I see.

23 Does it cost more if you have to make a new

24 mold?

25 A Of course.

The next section in dispute is as follows:

“The Boston round bottle is the most common bottle with many utility applications used in laboratory and life Science industry.” (Opposer’s Reply Brief)

The statement is supported by pages 7, lines 22-25 of the transcript of the Lin deposition testimony.

7

22 But my opinion is that the Boston

23 round bottle has exist in the market for almost a

24 dec- -- a century, and it should not be trademarked to

25 anyone by adding tether cap.

The statement is also supported by pages 8, lines 1-7 of the transcript of the Lin deposition testimony.

8

1 Q Was the Nalgene bottle originally without the

2 tether cap?

3 A Yes, in the laboratory, they sell the same

4 bottle without the tether cap. And by adding the tether

5 cap, they sell in the outdoor market, and this is the one

6 they want to trademark today. And it's actually the
7 simple Boston round bottle with tether.

The next section in dispute is as follows:

Nalgene was not the first seller of the Boston Round Design. Nalgene was not the first to adopt a tethered cap. The same caps have been available with connector on water canteens since World War II as seen in the exhibits. The same polycarbonate bottle being claimed as a trademark is sold in the laboratory market as a media and reagent bottle.

Nalgene's market position strategies place the bottles without a tether in the lab market as Boston round media bottles as seen on the Nalgene Labware page. These are the same bottles that are being marketed here with the same cap but no tether on the cap.

(Opposer's Reply Brief)

The statement is supported by Applicant's Exhibit 36 of the Lin deposition testimony.

The statement is also supported by pages 8, lines 1-7 of the transcript of the Lin deposition testimony.

8

1 Q Was the Nalgene bottle originally without the

2 tether cap?

3 A Yes, in the laboratory, they sell the same

4 bottle without the tether cap. And by adding the tether

5 cap, they sell in the outdoor market, and this is the one

6 they want to trademark today. And it's actually the

7 simple Boston round bottle with tether.

The next two sections in dispute are as follows:

The Boston Round Bottle is commonly used in the lab market for roller-culturing and roller label applicator. TriForest also sells Boston Round Bottles with Tether caps in all its market without any distinction to the consumer. The tethered cap bottles are available in the lab market, (Opposer's Reply Brief)

For the plastic resin, the Boston round bottle claimed is the simplest bottle to manufacture. (Opposer's Reply Brief)

These statement are supported by pages 11, 12 of the Lin deposition testimony.

11

21 Q This bottle, you call it a Boston round.

22 Is this a Boston round in Exhibit 3?

23 A Yes, this is a Boston round bottle with the
24 tether cap.

25 Q Why is it called Boston round?

12

1 A This is -- this term has been used in the
2 laboratory market for almost a century, like in early
3 19- -- 1900, and some company introduced this term. I
4 don't have a detail information, but Boston round term is
5 very common term for a cylindrical long shape of bottle
6 in the laboratory market.

7 Q And why was the bottle made cylindrical?

8 A In the laboratory there are many features. The

9 cylindrical bottle is the -- the strongest structure for

10 a bottle. And in the -- in the laboratory people use the

11 bottle to roll for culturing, and this is the simplest

12 way to mold the bottle in plastic.

13 Q The shoulder of the bottle, I notice that

14 that's round.

15 Why is the shoulder of the bottle round?

16 A Because the neck is narrower, so they have to

17 create a shorter interconnect to the -- the narrow mouth

18 and to the side wall. And it's a -- the rounded edge is

19 actually a stronger structure for a bottle like this.

20 Q You mean stronger than a rectangular?

21 A Yes, stronger than a rectangular.

22 Q Okay. Does it also hold more volume?

23 A Yes, actually, with the same material -- same

24 amount of material, one cylindrical bottle actually holds

25 more material, actually create more volume.

The next section in dispute is as follows:

“Also, customers are likely to pay higher prices on a product that is public domain, and clearly has no difference in material (resin used) and the properties of the resin.”

(Opposer's Reply Brief)

The disputed sentence is an inference that the opposer wants the Board to infer from the previous sentence, “The unfair monopoly granted by this trademark would prevent companies such as Triforest from selling a functionally equivalent product.” (Opposer’s Reply Brief) Therefore, this is a public policy argument so that the Board can consider the possible dangers of granting functional trademarks. It is basic high school economics that monopolies increase prices. The opposer does not need to submit testimony from an expert witness regarding this public policy matter. The Board is fully aware of the possible dangers and risks of granting functional trademarks.

Other related sections to the public policy argument address the issue that NNI does not want to be seen as an unfair bully. Unfortunately for NNI, the granting of a functional trademark would necessarily establish such an unfair relationship. Therefore, the public policy arguments are not scandalous or unwarranted under Rule 12(f).

Another disputed sentence is, “Nalgene is a large company that is trying to use its size to monopolize a functional public domain design.” This is not scandalous or unwarranted under Rule 12(f). The entire paragraph reads, “Nalgene is a large company that is trying to use its size to monopolize a functional public domain design. Just because a company is large and employing about a thousand people, does not mean that the goods it sells have automatically acquired secondary meaning. There is no presumption that large numbers of sales or employees automatically lead to secondary meaning covering every aspect of the product configuration, especially here because the claimed features are commonplace and functional.” The applicant’s argument is that NNI is a big company and has sold a large number of goods and that therefore

many features of the design have automatically acquired secondary meaning and are not functional. Opposer is simply pointing out that applicant's argument is incorrect. NNI takes the first sentence out of context.

B. TRIFOREST'S REPLY BRIEF EXHIBITS WERE DEMONSTRATIVE RATHER THAN SUBSTANTIVE AND THEREFORE NOT IMPROPER

Opposer TriForest agrees that the reply brief exhibits are not to be considered substantive evidence. If TriForest had wanted to make the exhibits substantive evidence, TriForest would have complied with 37 C.F.R. §2.122(c) requiring that the exhibit was identified and introduced into evidence as in exhibit during the period for taking of testimony. Instead, the evidence is demonstrative.

The first discussion of the bottle neck design was regarding US Trademark Registration #2,857,283. The court knows what US Trademark Registration #2,857,283 days, but for ease of reference, an exhibit was attached of applicant promotional materials.

C. CITATION OF MARGARET GREGORY'S STATEMENT WAS NOT IMPROPER

Margaret Gregory's statement, by definition could not possibly have been confidential. If it were confidential, the statement would be false. If Margaret Gregory's statement were confidential, the Board could simply seal the reply brief rather than strike the Margaret Gregory statement. Therefore, the objection to Margaret Gregory's statement is not proper. The protective order does not apply to Margaret Gregory's statement, because it would be logically contradictory for the statement to be confidential.

**D. TRIFOREST DID NOT PROFOUND DISCOVERY BECAUSE TRIFOREST
ALREADY SUFFICIENT EVIDENCE TO PROVE FUNCTIONALITY AND LACK OF
DISTINCTIVENESS BEFORE THE CASE WAS FILED**

NNI argues that TriForest somehow acted improperly by not propounding discovery. TriForest already had sufficient evidence, and did not require NNI documents regarding the alleged trademark. NNI's advertising materials are widely available, as are sample products, as are records from the United States Patent and Trademark Office, as are identity of witnesses. TriForest therefore conserved NNI's financial resources, so NNI is not complaining about this. Rather, NNI seems to be arguing that the total amount of documents is somehow proportional to the strength of TriForest's case.

The volume of paper, or megabytes of electronic documents is not somehow linearly proportional to the strength of TriForest's arguments. Proving functionality does not require numerous boxes of documents in this case. Proving functionality does not require numerous witnesses and multiple expert testimony in this case. The trademark is plainly functional and the functions of the trademark elements are easily described. The opposer submitted sufficient evidence to prove its case. Adding more simply wastes time and creates judicial inefficiency.

**E. TRIFOREST'S TRIAL TESTIMONY WAS SUFFICIENT TO PROVE
FUNCTIONALITY AND LACK OF DISTINCTIVENESS**

The depositions of NNI's witnesses were arranged in various cities on varying days and would have required a substantial amount of travel. TriForest would not have benefited from cross-examination of these witnesses. TriForest offered to stipulate that depositions could proceed by

affidavit. NNI refused. Therefore, NNI intentionally incurred these costs and travel expenses.


In any case, the total number of hours of deposition testimony is irrelevant to the central issue of the functionality of the trademark. The opposer submitted sufficient evidence to prove its case.

TriForest presented some facts that would lead to an inference that the NNI Mark is cheaper or simpler in manufacturing, however TriForest did not have a numerical data comparison because such a numerical data comparison would not be feasible. TriForest does not have numerical comparison data between the different bottles because capturing such data would not be feasible or possible.

E. CONCLUSION

NNI argues that sections of the reply brief should be stricken. TriForest opposes striking of the sections of the reply brief. TriForest not only pursued the opposition in good faith, but has made a clear showing that the mark is functional and lacking secondary meaning. For example, TriForest explained the function of the tether cap, top button and related elements. NNI does not dispute that the tether cap, top button and related elements have a function. NNI totally failed to identify specific ornamental features of the claimed trademark. Therefore, portions of the reply brief should not be stricken, and the opposition should be sustained.

Respectfully submitted,

By Clement Cheng, Esq. 
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Fountain Valley, CA 92708
Phone: (714) 825-0555

Date: March 23rd, 2007

Attorney for Opposer

PROOF OF SERVICE

In the matter of trademark application Serial No. 76/572,253

I, the undersigned, declare I am over the age of 18 and not a party to this action. My business address is at 17220 Newhope St., Suite 127 Fountain Valley, CA 92708.

On March 23rd, 2007, I served:

**OPPOSER'S RESPONSE TO NNI OBJECTIONS TO AND MOTION TO STRIKE
PORTIONS OF OPPOSER REPLY BRIEF;
OPPOSITION TO MOTION FOR SANCTIONS**

By placing true copies thereof in a sealed envelope, addressed as follows to:

1 copy sent to:

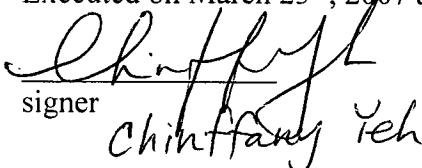
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- ☐ BY PERSONAL SERVICE: I caused such envelope to be delivered by hand to the offices of the addressee(s).
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- ☒ FEDERAL: I declare under penalty of perjury under the laws of the United States that the foregoing is true and that I am employed in the office of a member of the Bar of this Court at whose direction the service was made.
- ☐ STATE: I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct.

Executed on March 23rd, 2007 at Fountain Valley, California.


signer
Chinfang Yeh